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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS**

In re application of:

BENSON et al.

Application No.: 09/679,948

Filed: November 4, 2000

For: System and Method for Manipulating
Digital Images

Examiner: Good Johnson, Motilewa

Art Unit: 2672

**REQUEST FOR REINSTATEMENT OF
THE APPEAL AND SUPPLEMENTAL
APPEAL BRIEF UNDER 37 C.F.R.
§1.192**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Appellant requests Reinstatement of Appeal and submits this Supplemental Appeal Brief in furtherance of the Request for Reinstatement of Appeal for the above-referenced patent application. There is no fee for the Reinstatement Request, but authorization is granted to deduct extension fee or any additional fees or credit any excess fees associated with the Appeal Brief to deposit account 501861. Appendix A, attached hereto, contains a copy of all claims pending in this case.

REAL PARTY IN INTEREST

All right, title, and interest in the subject invention and application are assigned to Shutterfly, Inc., having offices at 2800 Bridge Parkway, Suite 101, Redwood City, CA 94065. Therefore, Shutterfly, Inc. is the real party interest.

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RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-45 were originally presented in the application. Claims 1-45 have been rejected and are the subject of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

A Final Office Action was mailed on September 29, 2003. No amendment has been filed in response to the Final Office Action. An Appeal Brief was filed on February 14, 2004, and an Office Action was mailed on September 10, 2004 setting new grounds of rejection. A copy of all the pending claims is provided in Appendix A, attached hereto.

SUMMARY OF THE INVENTION

The present invention is related generally to distributing images. In one aspect, the invention allows images to be edited and the specified edits are saved as metadata and the original image is not altered. During review of an edited/manipulated image, the original image is retrieved and metadata specifying the edit changes are applied to the original image to arrive at the edited image. The metadata is generated at the user's local computer, and the metadata is updated to a remote server that archives the image and the metadata. In this manner, the original image is read-only so that the user can always revert to the original image if needed.
Specification at page 4.

Aspects of the invention can include one or more of the following features. The synchronizing step can include updating local client software for manipulating the image. The manipulating step can include manipulating a proxy image associated with the image. The proxy image can be a lower or higher resolution image than the image. The step of manipulating the proxy image can include creating metadata describing the manipulations to the image, applying the metadata to the proxy image and displaying the modified proxy image. The manipulating step can include displaying to the user a modified image including selecting between the image and a proxy image, modifying the selected image in accordance with the manipulation parameters, and displaying the modified selected image. The method can include storing the metadata as a file associated with the image at each of the local client computer and the remote server. The metadata can include rotation information, cropping information and user

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interface state information. The step of manipulating the parameters can include capturing state information defining a state of the manipulations at a predefined time and selecting a previous state at the request of the user. The method can include capturing a history of the state information and selecting any of the previous states without traversing back through each intermediary state in the history. The parameter that can be manipulated can be selected from image parameters, account parameters and order parameters. The image parameters can include the state of the user interface, image archival information, annotation information, backprint information and order information. The order information can include pricing information. The method can include defining a personal template that describes a particular configuration for the parameters for a given image and wherein the image parameters includes an identifier pointing to the personal template. The account parameters can include verification data for the client. The order parameters can include envelope information. The synchronization step can be bi-directional. The synchronization step can include checking for conflicts between metadata stored at the local client computer and the remote server and upon detecting a conflict, alerting the user to the conflict. The method can include receiving a selection from the user regarding the client and synchronizing the local client computer and remote sever in accordance with the selection. When a conflict arises, two different states of the metadata at each of the local client computer and the remote server, one for each of the conflicting parameters, can be stored. The step of alerting the user can include displaying a dialog box to the user from which a selection can be made. The method can include storing on the local client computer a printer output file including profiles for different printers available through the remote server, wherein the step of manipulating the parameters includes displaying a modified version of the original image in accordance with the manipulated parameters and using an output profile for a printer on which the image is to be outputted when transferred to the remote server. The method can include displaying on both the local client computer and the remote server a similar image metaphor for manipulating the original image. The image metaphor can include an envelope for dropping selected images into when ordering. The method can include prompting the user to experience a new remote server function including loading a copy of a tool onto the local client computer during the synchronization step and displaying an icon in the user interface that alerts the user to the new functionality and includes a link to the local copy of the tool to allow the user to manipulate an image using the new functionality. The method can include storing metadata describing the manipulations without modifying the image, the metadata being stored at the computer, either the local client or the remote server, where the manipulating step is performed.

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The local client computer can be selected from the group of PDA, portable computer, kiosk, fax machine, digital camera and docking station. The connection between the local client computer and remote server can be wireless. The synchronization step can occur in real-time, at a next open session or at the end of a session between the local client computer and the remote server. The synchronization step occurs in real time between the local client computer and remote server. The parameters can include print parameters and display parameters. The print parameters can include print calibration parameters. Specification at page 5-8.

The proposed client-based software tracks the processing changes by the user on each particular image. The software also offers an incremental undo function so that the user can change back to a previous image state if he/she decides to try something different. The history of the image processing and undo functions is stored and synchronized between the client computer and online server so that it can be used analogously on both the web (e.g., the server) and the client computer. Specification at page 5-8.

Personal templates can be saved that define a particular set or chain of image processing operations often used by a user. The metadata file can also include the states (i.e. the user interface (UI) settings) of the UI at the time the image operations are invoked by the user. Unique UI state information can be associated with each image. The UI states can be transferred from the client to the server along with the source image. If the source image is already stored in the user account on the server, only the metadata file needs to be transferred to the server and updated in the user account. The preservation and storing of the UI states allows the user to recover the exact display condition he/she created on a different client computer or on the website. Specification at page 8.

Each time a connection to the user's account at the online photofinisher's website is made, the state information of the user account is updated on the user computer and on the web. The state information can include image transfers or upload, the transfer of an image file name, image processing information, image archival information, annotation and back printing information, UI state information, personal template, and order information. The input information on the user's computer can be automatically uploaded to the user account on the web. Specification at page 8.

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ISSUES

- I. Whether claims 1-23, 25-31 and 33-45 are anticipated by Wilkins (2004/0133924).
- II. Whether claims 24 and 32 are unpatentable under 35 U.S.C. § 103(a) over Wilkins and Tackbary (6,092,054).

ARGUMENT

I. Claims 1-23, 25-31 and 33-45 are not anticipated by Wilkins.

Claims 1-23, 25-31 and 33-45 were rejected as anticipated by Wilkins, which relates to automatically synchronization of associated multimedia assets. A particular one of the set of distributed multimedia assets is modified and the others of the set of distributed multimedia assets are then synchronized based upon the modification. An update edit list corresponding to the modification is generated which is then automatically forwarded to the others of the set of distributed multimedia assets. The update edit list is then used to synchronize each of the distributed multimedia assets to the particular multimedia asset so modified.

The Office Action noted as follows:

Regarding claim 1, Wilkins discloses a method for manipulating a digital image (0002, digital image processing) comprising: identifying an image for processing at a local client computer (0113, line 7, image processed by the local computer device) sending the image to a remote server (0113, lines 12-15, saving changes to the server over the network from a local computing device); manipulating either locally or remotely parameters associated with the image without modifying the image itself (0113, transmitting the edit list and other metadata to the remote computing device); synchronizing the local client computer and remote server including updating metadata for one of the local client computer and the remote server using metadata of the other. (0115, lines 1-4, synchronizing all associated multimedia assets whether locally or remotely)

While Wilkins relates to synchronization of multimedia assets, Wilkins fails to show the claimed specifics of:

- identifying an image for processing at a local client computer;
- sending the image to a remote server;
- manipulating either locally or remotely parameters associated with the image without modifying the image itself; and
- synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.

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First, Wilkins does not identify an image for processing at the local computer and send the image to a remote server. In fact, Wilkins teaches the opposite as follows: "However, this invention allows for a more efficient alternative approach that calls for a low resolution-image to be downloaded from the remote computing device (such as the server computer 406) and processed by the local computer device (such as the host computer 402-1 or photo appliance 403-1)." Wilkins at 113, lines 3-7. Since Wilkins lacks these two elements, each is an independent basis requiring withdrawal of the Section 102 rejection.

Moreover, Wilkins fails to show the specifics of the dependent claims. For example, regarding claim 2, Wilkins does not disclose synchronizing step includes updating local client software for manipulating the image since synchronizing an updated edit list for a modified photo simply synchronizes the data, but not the local client software to manipulate the image. Regarding claim 3, Wilkins' modified proxy image on 030, line 17 relates to an image or thumbnail of the image that contains the results of the edits applied to the negative. However, this is not disclosing manipulating step includes manipulating a proxy image associated with the image. Regarding claim 4-6, Wilkins fails to disclose the proxy image for the same reason.

As to claim 43, Wilkins fails to show the specifics of:

Determining if a session is open between the local client computer and the remote server;

Capturing, at the client computer when the session is closed, metadata describing any manipulations by the user of an image;

Capturing, at the remote server when the session is opened, metadata describing manipulations of the image by the user; and

Synchronizing the metadata captured at each of the local client computer and the remote server when the session is open.

As to claim 44, Wilkins fails to show:

dividing image management, archival, and printing functions among the local client computer and the remote server including performing image management at either

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of the local client computer and the remote server, and performing image archive and printing functions at the remote server; and

synchronizing image management data between the local client computer and the remote server.

As to claim 45, as discussed above, Wilkins fails to show the client software for executing on a local client computer including instructions for

identifying an original image for processing at the local client computer,

uploading the original image to a remote server,

receiving a user selection to locally or remotely process the original image;

if local processing is selected, locally manipulating parameters associated with the original image including storing, on the local client computer, metadata describing the manipulations without modifying the original image,

if remote processing is selected, opening a session with the remote server; and

Remote server software for executing on the remote server including instructions for

receiving the original image,

manipulating parameters associated with the original image in accordance with instructions received from the local processor

storing metadata describing the manipulations without modifying the original image, and

at each session between the local client computer and the remote server, synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.

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Since the elements of the independent claims are missing, the independent claims as well as those dependent therefrom cannot be anticipated by Wilkins. Withdrawal of the Section rejection is requested.

II. Whether claims 24 and 32 are unpatentable under 35 U.S.C. § 103(a) over Wilkins and Tackbary (6,092,054).

Claims 24 and 32 were rejected as unpatentable under 35 U.S.C. § 103(a) over Wilkins and Tackbary (6,092,054). The standard for a Section 103 rejection is stated in MPEP Section 706.02(j) is as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First,

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the Examiner must show some suggestion or motivation, either in Wilkins, Tackbary, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991).

Here, as discussed above, Wilkins fails to disclose a number of recited elements of the independent claims. Tackbary fails to show these missing elements. Hence, none can render the claims obvious.

Moreover, the criteria have not been met: there is absolutely no suggestion or motivation; there is no expectation of success for the modification, and a plurality of claim limitations are missing.

In sum, since neither Wilkins nor Tackbary shows the claimed elements recited in claim 1, Applicants submit that neither can render obvious any of the independent claims. The dependent claims are allowable since they depend from allowable independent claims. Withdrawal of the Section 103 rejection is respectfully requested.

CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set for the in the Final Office Action.

Authorization to charge Deposit Account 501861 is granted.

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If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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CLAIMS

1. A method for manipulating a digital image comprising:

identifying an image for processing at a local client computer;

sending the image to a remote server;

manipulating either locally or remotely parameters associated with the image without modifying the image itself; and

synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.
2. The method of claim 1 wherein the synchronizing step includes updating local client software for manipulating the image.
3. The method of claim 1 wherein the manipulating step includes manipulating a proxy image associated with the image.
4. The method of claim 3 wherein the proxy image is a lower resolution image than the image.
5. The method of claim 3 wherein the proxy image is a higher resolution image than the image.
6. The method of claim 3 wherein the step of manipulating the proxy image includes creating metadata describing the manipulations to the image, applying the metadata to the proxy image and displaying the modified proxy image.
7. The method of claim 1 wherein the manipulating step includes displaying to the user a modified image including
 - a. selecting between the image and a proxy image, the proxy image being a lower resolution copy of the original image,
 - b. modifying the selected image in accordance with the manipulation parameters, and

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- c. displaying the modified selected image.
8. The method of claim 1 further comprising storing the metadata as a file associated with the image at each of the local client computer and the remote server.
9. The method of claim 1 wherein the metadata includes rotation information.
10. The method of claim 1 wherein the metadata includes cropping information.
11. The method of claim 1 wherein the metadata includes user interface state information.
12. The method of claim 1 wherein the step of manipulating the parameters includes capturing state information defining a state of the manipulations at a predefined time and selecting a previous state at the request of the user.
13. The method of claim 12 further comprising capturing a history of the state information and selecting any of the previous states without traversing back through each intermediary state in the history.
14. The method of claim 1 wherein the parameter that can be manipulated can be selected from image parameters, account parameters and order parameters.
15. The method of claim 14 wherein the image parameters include the state of the user interface.
16. The method of claim 14 wherein the image parameters include image archival information.
17. The method of claim 14 wherein the image parameters include annotation information.
18. The method of claim 14 wherein the image parameters include backprint information.
19. The method of claim 14 wherein the image parameters include order information.

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20. The method of claim 19 wherein the order information includes pricing information.

21. (Amended) The method of claim 19 wherein the image parameters includes archival information.

22. The method of claim 14 further comprising defining a personal template that describes a particular configuration for the parameters for a given image and wherein the image parameters includes an identifier pointing to the personal template.

23. The method of claim 14 wherein the account parameters include verification data for the client.

24. The method of claim 14 wherein the order parameters includes envelope information.

25. The method of claim 1 wherein the synchronization step is bi-directional.

26. The method of claim 1 wherein the synchronization step includes

Checking for conflicts between metadata stored at the local client computer and the remote server; and

Upon detecting a conflict, alerting the user to the conflict.

27. The method of claim 26 further comprising receiving a selection from the user regarding the client and synchronizing the local client computer and remote sever in accordance with the selection.

28. The method of claim 26 further comprising storing two different states of the metadata at each of the local client computer and the remote server, one for each of the conflicting parameters.

29. The method of claim 26 wherein the step of alerting the user includes displaying a dialog box to the user from which a selection can be made.

30. The method of claim 1 further comprising storing on the local client computer a printer output file including profiles for different printers available through

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the remote server, wherein the step of manipulating the parameters includes displaying a modified version of the original image in accordance with the manipulated parameters and using an output profile for a printer on which the image is to be outputted when transferred to the remote server.

31. The method of claim 1 further comprising displaying on both the local client computer and the remote server a similar image metaphor for manipulating the original image.

32. The method of claim 1 wherein the image metaphor includes an envelope for dropping selected images into when ordering.

33. The method of claim 1 further comprising prompting the user to experience a new remote server function including loading a copy of a tool onto the local client computer during the synchronization step and displaying an icon in the user interface that alerts the user to the new functionality and includes a link to the local copy of the tool to allow the user to manipulate an image using the new functionality.

34. The method of claim 1 further comprising storing metadata describing the manipulations without modifying the image, the metadata being stored at the computer, either the local client or the remote server, where the manipulating step is performed.

35. The method of claim 1 wherein the local client computer is selected from the group of PDA, portable computer, kiosk, fax machine, digital camera and docking station.

36. The method of claim 1 wherein the connection between the local client computer and remote server is wireless.

37. The method of claim 1 wherein the synchronization step occurs at a next open session between the local client computer and the remote server.

38. The method of claim 1 wherein the synchronization step occurs at the end of current session between the local client computer and the remote server.

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39. The method of claim 1 wherein the synchronization step occurs in real time between the local client computer and remote server.
40. The method of claim 1 wherein the parameters include print parameters.
41. The method of claim 40 wherein the parameters include print calibration parameters.
42. The method of claim 1 wherein the parameters include display parameters.
43. A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:
- Determining if a session is open between the local client computer and the remote server;
 - Capturing, at the client computer when the session is closed, metadata describing any manipulations by the user of an image;
 - Capturing, at the remote server when the session is opened, metadata describing manipulations of the image by the user; and
 - Synchronizing the metadata captured at each of the local client computer and the remote server when the session is open.
44. A method for distributing image editing, review and ordering functions among system resources in an image-processing system, the image-processing system including a local client computer and a remote server, the method comprising:
- Dividing image management, archival, and printing functions among the local client computer and the remote server including performing image management at either of the local client computer and the remote server, and performing image archive and printing functions at the remote server; and
 - Synchronizing image management data between the local client computer and the remote server.

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45. An apparatus for manipulating a digital image comprising:

Client software for executing on a local client computer including instructions for identifying an original image for processing at the local client computer, uploading the original image to a remote server, receiving a user selection to locally or remotely process the original image;

if local processing is selected, locally manipulating parameters associated with the original image including storing, on the local client computer, metadata describing the manipulations without modifying the original image,

if remote processing is selected, opening a session with the remote server; and

Remote server software for executing on the remote server including instructions for

receiving the original image,

manipulating parameters associated with the original image in accordance with instructions received from the local processor

storing metadata describing the manipulations without modifying the original image, and

at each session between the local client computer and the remote server, synchronizing the local client computer and the remote server including updating metadata for one of the local client computer and the remote server using metadata of the other.

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EVIDENCE APPENDIX

NONE

RELATING PROCEEDINGS

NONE